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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,560	07/25/2003	Eric L. Andersen	200209473-1	5231

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EXAMINER	
MORRISON, THOMAS A	

ART UNIT	PAPER NUMBER
3653	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/627,560	ANDERSEN ET AL.	
	Examiner	Art Unit	
	Thomas A. Morrison	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-8, 10-12 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmle).

Regarding claim 1, Figs. 1 and 8 show a media handling system for an image forming device (including 10) configured with a primary media path (from 28 to 30 and then past 32, 39, 33 and into 34) and a duplex media path (from 39 to 42 in Figs. 1 and 8, and then past 40 in Fig. 8 and back up through 88 in Fig. 1 and into 28), the media handling system comprising:

a media feeder (including 84 and 83 in Fig. 8) positioned adjacent to one side of the image forming device (10) and configured to input print media (Fig. 8) into the duplex media path (i.e., input print media at the outlet of 40 in Fig. 8) of the image forming device (including 10), and the media feeder (including 84 and 83 in Fig. 8) being positioned to not be part of the duplex media path.

Regarding claim 2, Figs. 1 and 8 show that the duplex media path is a substantially horizontal media path. In as much as applicant does not set any specific

angular tolerance limits for the term "substantially horizontal", it is the examiner's position that the duplex path of Stemmle is substantially horizontal.

Regarding claim 3, Figs. 1 and 8 show that the media feeder (including 84 and 83 in Fig. 8) is configured to automatically input non-imaged media into the duplex media path of the image forming device. See also column 9, line 68 to column 10, line 3.

Regarding claim 4, Figs. 1 and 8 show that the media feeder (including 84 and 83 in Fig. 8) includes a high-capacity media storage unit (83) to store a quantity of media.

Regarding claim 5, Figs. 1 and 8 show that the media feeder (including 84 and 83) is configured to be detachably mounted to the one side of the image forming device. More specifically, Figs. 1 and 8 show different units that can be added to the bottom of the image forming device (including 10). Fig. 1 shows a unit having only a duplex device (40) that can be added to the image forming device, while Fig. 8 shows an alternative unit with a duplex device (40) as well as a media feeder (including 84 and 83) that can be added to the image forming device. As such, these different units can be attached and detached.

Regarding claim 6, Fig. 1 shows a media output unit (including 34) configured to be positioned adjacent to the one side of the image forming device (including 10) to receive media discharged from the image forming device.

Regarding claim 7, Figs. 1 and 8 show that the media feeder (including 84 and 83 in Fig. 8) and the media output unit (including 34) are configured to be vertically-stacked to reduce a footprint of the image forming device.

Regarding claim 8, Figs. 1 and 8 show that the media feeder (including 84 and 83 in Fig. 8) and the media output unit (including 34) are integral within a housing (i.e., the entire outer casing).

Regarding claim 10, Figs. 1 and 8 show a media handling apparatus for inputting non-imaged media (Fig. 8) into an image forming device (including 10) having a primary media path (from 28 to 30 and then past 32, 39, 33 and into 34) along which an image is formed on a print media, the handling apparatus comprising:

a return media path (from 39 to 42 in Figs. 1 and 8, and then past 40 in Fig. 8 and back up through 88 in Fig. 1 and into 28) configured to selectively receive imaged print media (31) from the primary media path and return the imaged media (31) to the primary media path for multiple imaging;

a media input unit (including 84 and 83 in Fig. 8) configured for attachment to one side of the image forming device (including 10) to input non-imaged media (Fig. 8) into the return media path of the image forming device (i.e., input print media at the outlet of 40 in Fig. 8), where the media input unit (including 84 and 83 in Fig. 8) is positioned where the return media path does not return the imaged media (31) across the media input unit (including 84 and 83 in Fig. 8) during duplex printing; and

a media output unit (including 34 in Fig. 1) for receiving imaged media (31) discharged from the primary media path, the media output unit (including 34) being configured for attachment to the one side of the image forming device (including 10) and stacked above of the media input unit (including 84 and 83 in Fig. 8).

Regarding claim 11, Figs. 1 and 8 show that the return media path is a substantially horizontal path. In as much as applicant does not set any specific angular tolerance limits for the term "substantially horizontal", it is the examiner's position that the duplex path of Stemmle is substantially horizontal.

Regarding claim 12, Figs. 1 and 8 show that the media input unit (including 84 and 83 in Fig. 8) further comprises a media storage unit (83) to store a quantity of non-imaged media.

Regarding claim 14, Figs. 1 and 8 show that the media feeder (including 84 and 83) is configured to be detachably mounted to the one side of the image forming device. More specifically, Figs. 1 and 8 show different units that can be added to the bottom of the image forming device (including 10). Fig. 1 shows a unit having only a duplex device (40) that can be added to the image forming device, while Fig. 8 shows an alternative unit having a duplex device (40) and a media feeder (including 84 and 83) that can be added to the image forming device. As such, these different units can be attached and detached.

Regarding claim 15, Figs. 1 and 8 show that the media input unit (including 84 and 83 in Fig. 8) and the media output unit (including 34 in Fig. 1) are integral within a common housing (i.e., the entire outer casing).

Regarding claim 16, Figs. 1 and 8 show an image forming apparatus comprising:

a housing (Fig. 1) having at least one wall;

an image forming unit (including 14) provided within the housing for forming an image onto print media;

a media storage unit (including 83 in Fig. 8) configured to store a supply of non-imaged print media;

a primary media path (from 28 to 30 and then past 32, 39, 33 and into 34) for carrying print media to the image forming unit (including 14) for imaging;

a duplex media path (from 39 to 42 in Figs. 1 and 8, and then past 40 in Fig. 8 and back up through 88 in Fig. 1 and into 28) configured to receive imaged print media from the primary media path and return the imaged print media to the primary media path for duplex imaging where the returned imaged media is not returned to the media storage unit (including 83 in Fig. 8) during the duplex imaging; and

the duplex media path (from 39 to 42 in Figs. 1 and 8, and then past 40 in Fig. 8 and back up through 88 in Fig. 1 and into 28) being configured to receive non-imaged print media (media in Fig. 8) from the media storage unit (including 83 in Fig. 8) and to input the non-imaged print media to the primary media path for imaging.

Regarding claim 17, Fig. 1 shows a media output unit (including 34) positioned to receive imaged print media discharged from the primary media path where the media storage unit (including 83 in Fig. 8) and the media output unit (including 34) are stacked to reduce a footprint of the image forming apparatus.

Regarding claim 18, Figs. 1 and 8 show a media feeder (84) to feed the non-imaged print media from the media storage unit (including 83 in Fig. 8) to the duplex media path.

Regarding claim 19, Figs. 1 and 8 show that the media storage unit (including 83 in Fig. 8) and the media output unit (including 34) are contained within a common housing (i.e., the entire outer casing).

2. Claim 21 is rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,042,791 (Stemmle) or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,042,791 (Stemmle) in view of U.S. Patent No. 5,724,642 (Cala).

Regarding claim 21, Fig. 1 of Stemmle shows a gate (39) that determines whether print media is inputted into the primary media path (including 33) or the duplex media path (including 42). Inherent in the operation of this gate is some sort of logic to determine whether print media is to be inputted into the primary media path or the duplex media path. Alternatively, the Cala patent discloses that it is well known to operate sheet deflecting fingers via logic (e.g., signals from a microprocessor) to direct sheets to different paths. See, e.g., gate 24 in Fig. 1, column 3, lines 8-25 and column 4, lines 4-8 of the Cala patent. It would have been obvious to one of ordinary skill in the

art at the time the invention was made to control the gate (39) of Stemmle via signals from a microprocessor (logic) because this is the way that gates (sheet deflecting fingers) are conventionally operated in the art, as taught by the Cala patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 9, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,042,791 (Stemmle) as applied to claims 6, 10 and 16 above, and further in view of U.S. Patent No. 6,308,948 (Azumi). Regarding claims 9, 13 and 20, the Stemmle patent discloses all of the features of these claims, except for a media finishing device.

The Azumi patent discloses that it is well known to provide an output unit (20) with a stapler (including 21) to allow a plurality of sheet bundles to be formed in the output unit (20). See, e.g., Abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the output unit (including 34) of Stemmle with a stapler (media finishing device) to allow a plurality of sheet bundles to be formed, as taught by Azumi.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 10 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

07/12/2006

GENE O. CRAWFORD
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